



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,512	10/24/2003	Tor McPartland	57974-5006	9303
<div>7590 11/29/2007</div> <div>ROD S. BERMAN, ESQ. JEFFER, MANGELS, BUTLER & MARMARO LLP Seventh Floor 1900 Avenue of the Stars Los Angeles, CA 90067</div> <div>EXAMINER PRYOR, ALTON NATHANIEL</div> <div>ART UNIT PAPER NUMBER 1616</div> <div>MAIL DATE DELIVERY MODE 11/29/2007 PAPER</div>				

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/692,512	Applicant(s) MCPARTLAND, TOR	
	Examiner Alton N. Pryor	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 9-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 9-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's arguments filed 9/17/07 have been fully considered but they are not persuasive. See rejections below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6,9-11, 13-17, 22,23 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Dotolo (US 4379168; 4/5/83). Dotolo teaches a composition comprising 20 % d-limonene, 4 % emulsifier (surfactant), and remainder water (76 %). See Example 14. Dotolo teaches that the d-limonene contains a preservative. See column 6 lines 40-43. Dotolo teaches that the composition can repel or kill insects. See column 7 lines 34-43. Dotolo teaches that the composition controls lice. See column 7 lines 3-4. Dotolo teaches a method of applying the composition to house surfaces such as walls and floors and to animals as a topical application. See column 7 lines 5-11. Dotolo teaches that the composition can be made by the simple act of mixing d-limonene, emulsifier, and remainder water. See claims 34 –36. Dotolo teaches that nonionic emulsifiers (surfactants) such as TON X-100 and IGEPAL CO-630 are specifically used in his invention. See column 1 lines 52-68. Dotolo explains that these surfactants contain a number of ethylene oxide (EO) units. See column 1 line 68 –

column 2 line 3. Dotolo also teaches that his invention is open to other suitable surfactants, which can be nonionic, cationic, anionic and amphoteric type. See column 2 lines 4-10. Dotolo teaches all that is recited in claims except for the invention comprising 1) a polyethoxylated castor oil surfactant and 2) amount (0.01-5%) of preservative. However, in the absence of a showing of unexpected results for the prior art surfactants versus PEG-castor oil, it would have been obvious to one having ordinary skill in the art to modify the invention taught by Dotolo to include PEG-castor oil. One would have been expected to do this since Dotolo is open to the inclusion of suitable surfactants and since PEG-castor oil contains a number of EO units which are units also contained in the TON X-100 and IGEPAL CO-630 surfactants (Note that PEG-castor oil, TON X-100 and IGEPAL CO-630 are non-ionic surfactants). One would have been motivated to do this because all three surfactants are similar in chemical and physical properties and therefore, would have been expected to exhibit a similar function when used in the same capacity. It would have been obvious to one having ordinary skill in the art to determine the optimum amount of preservative to include in the composition. One would have been motivated to do this in order prevent the composition from becoming rancid.

Response to Applicants' Arguments

Applicant argues:

1. The chemical and physical properties of surfactants (Triton X-100 and IGEPAL CO-630) disclosed in Dotolo do not have similar chemical and physical properties to the surfactant disclosed in the instant invention, i.e. PEG-castor oil. MSDS sheets of IGEPAL CO-630, TRITON X-100 and PEG-castor oil are provided to support

applicant's position of the low toxicity of PEG castor oil versus the greater toxicity of IGEPAL CO-630 and TRITON X-100. IGEPAL CO-630 and TRITON X-100 are not listed as Generally Recognized As Safe (GRAS) chemicals.

2. A showing of unexpected results is only necessary when the prior art makes an invention obvious. In this case it is not necessary to provide unexpected results because Dotolo, the prior art, does not make the claimed invention obvious.

3. The combination of Dotolo and PEG-castor oil is improper since there is no support for the proposition that TRITON X-100 or IGEPAL CO-630 has similar chemical and physical properties to that of PEG-castor oil and Dotolo does not require a food grade surfactant as claimed.

4. Those skilled in the art know that many insecticides with surfactants other than PEG castor oil immobilize insects for a short period of time, but then they get up and walk off. Nowhere in Dotolo is it mentioned that the surfactant is required to have a high viscosity to make the insecticide more effective, i.e., PEG castor inhibits the insects from moving.

Examiner argues:

5. Triton X-100 and IGEPAL CO-630 and PEG castor oil are all similar chemically and physically since all three are nonionic surfactants. Note that Dotolo provides Triton X-100 and IGEPAL CO-630 as two suitable surfactants for the invention. However, note that Dotolo states that any suitable surfactant can be employed in a pesticide composition. Therefore, Dotolo is somewhat broad to the teaching of the inclusion of a surfactant in the composition. Since Triton X-100 and IGEPAL CO-630

are nonionic surfactants like PEG castor oil and since the inclusion of surfactants is broadly taught by Dotolo, it would have been obvious to replace TRITON X-100 or IGEPAL CO-630 in Dotolo by the PEG castor oil disclosed in instant claims to arrive at instant invention. The Applicant does not provide any data showing why the exchange of a simple surfactant, which is not even an active ingredient, would materially affect the activity of the composition. Until Applicant provides a showing demonstrating a difference in the effectiveness of TRITON X-100 and IGEPAL CO-630 versus PEG castor oil, the examiner maintains that Dotolo makes obvious that many surfactants including the PEG-castor oil instantly claimed are suitable for the invention taught therein. For the reasons stated above, the Examiner finds it necessary for the Applicant to provide a showing of unexpected results for PEG castor oil over TRITON X-100 and IGEPAL CO-630. While PEG castor oil is more viscous than TRITON-X-100 and IGEPAL CO-630 and prevents the freedom of movement of insects in comparison to TRITON-X-100 and IGEPAL CO-630, the Applicants do not show that their composition is more effective than Dotolo's composition. For examples, does Applicants' composition kill more insects than Dotolo's composition due to some toxicity associated with PEG castor oil? Note just because the insects may move once contacted with Dotolo's composition does not mean that Dotolo's composition is not effective in killing those insects. Note that the specification on page 4 defines "food grade" components as being "(Generally Recognized as Safe)". This language does not exclude TRITON X-100 and IGEPAL CO-630 taught by Dotolo since it is unclear as to what is meant by a "food grade" component being "(Generally Recognized as Safe)". Regardless that

TRITON-X-100 AND IGEPAL CO-630 are listed as GRAS, Dotolo does not teach that the composition therein is toxic because of the presence of TRITON-X-100 AND IGEPAL CO-630. For the above reasons the rejection of the claims in view of Dotolo is maintained. Since the Dotolo's composition is used on animals that may be in the area of humans. Dotolo does not report the animals or humans becoming ill. For this reason Dotolo's composition does not appear to be toxic to humans.

Claims 1-3,6,7,9,11-15,20,21,24 remain rejected under 35 U.S.C. 103(a) as being obvious over Liebman (CA 2060594; 8/6/92). Liebman teaches a method of applying a shampoo or lotion composition comprising d-limonene, emulsifiers (cocoamido propyl betaine, sodium lauryl sulphate, ethyl methacrylate) and water and / or alcohol to human head / hair / skin to contact lice. Liebman teaches that the method is used to prevent lice infestation in human hair and on skin. See page 1 lines 5-8, page 3 lines 5-22, and page 6 examples. Liebman teaches generically that emulsifiers can be added to his invention. See page 4 lines 16-19. Liebman also teaches that modifications to the disclosed embodiments can be made without departing from the scope of his invention. See page 9 lines 26-29. Liebman teaches all that is recited in claims except for the invention comprising 1) a polyethoxylated castor oil and 2) instant amounts / ranges of ingredients: d-limonene, emulsifying agent, and hydrophilic solvent. However, in the absence of a showing of unexpected results for the prior art surfactants versus PEG-castor oil, it would have been obvious to one having ordinary skill in the art to modify the invention taught by Liebman to include PEG-castor oil. One would have been expected to do this since Liebman generically teaches the inclusion of surfactants

(emulsifiers) and since Liebman also teaches that modification to the disclosed embodiments can be made without departing from the scope of his invention. With respect to the amount / ranges of ingredients, one having ordinary skill in the art would have been expected to determine the optimum amounts / ranges of ingredients. One would have been motivated to do this in order to develop a lotion that would have been effective in killing lice, but yet non-toxic to animals being treated.

Response to Applicants' Argument

Applicant argues Liebman cannot be used to render the instant invention obvious, because Liebman does not suggest or motivate one having ordinary skill at the time the invention was made to modify the invention with a food-grade composition. There is no disclosure in Liebman for insecticidal compositions which contain castor oil or which are composed of only food-grade ingredients. Liebman does not disclose a food grade composition or the need for a food grade composition

Examiner response: The specification on page 4 defines "food grade" components as being "(Generally Recognized as Safe)". This language does not exclude ingredients taught by Liebman since it is unclear as to what is meant by a "food grade" component being "(Generally Recognized as Safe)". What does the phrase "(Generally Recognized as Safe)" mean?

With respect to the obvious inclusion of PEG castor oil in Liebman, Liebman teaches generally that a surfactant can be added to his composition. Therefore, Liebman is broad to the surfactant added to the composition. For this reason, it would have been obvious to include PEG castor oil in Liebman's composition to arrive at the

instant invention. The Applicant does not provide any data showing why PEG castor oil is critical for the instant invention. Why wouldn't any surfactant be suitable? Until the Applicant provides a showing demonstrating the significance of PEG castor oil, the examiner maintains that Liebman makes obvious that any surfactant including the PEG-castor oil would have been suitable for the invention taught therein. For the reasons stated above, the Examiner finds it necessary for the Applicant to provide a showing of unexpected results obtained from using PEG castor oil in the instant invention as opposed to any other surfactant.

Also see arguments with respect to the Dotolo reference. Those arguments with respect to Dotolo apply here.

Claims 1,2,6,7,9,11-15,17-19,21,24 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkins, Jr. (US 5951991; 9/14/99). Wilkins, Jr. teaches a method of applying a composition comprising 2-10 % d-limonene, 1-10 % emulsifier, and 80-96 % water to crop or plants to control fire ant infestation. See abstract, column 2 line 1- column 3 line 35. Wilkins, Jr. teaches that a nonionic surfactant such as Mazclean is specifically used in his invention. See column 3 lines 9-10. Wilkins, Jr. also teaches that his invention is open to any suitable surfactant. See column 3 lines 7-9. Wilkins, Jr. does not teach 1) the invention comprising a polyethoxylated castor oil and 2) the invention comprising instant amounts / ranges of ingredients: d-limonene, emulsifying agent, and hydrophilic solvent, 3) the plants being rose bushes and ornamentals. However, in the absence of a showing of unexpected results for the prior art surfactant versus PEG-castor oil, it would have been obvious to one having ordinary

skill in the art to modify the invention taught by Wilkins, Jr. to include PEG-castor oil. One would have been expected to do this since Wilkins, Jr. is open to the inclusion of any suitable surfactant (Note that PEG-castor oil and Mazclean are non-ionic surfactants). One would have been motivated to do this because both surfactants are similar in chemical and physical properties and therefore, would have been expected to exhibit a similar function when used in the same capacity. Wilkins, Jr. teaches 2-10% d-limonene; whereas, the instant claims uses a high of 1.5% d-limonene. In the absence of unexpected results, one having ordinary skill in the art would expect Wilkins' composition comprising 2% d-limonene to yield similar if not the same results as the instant composition comprising 1.5% d-limonene, which is just slightly below 2%. With respect to the amount / ranges of ingredients, one having ordinary skill in the art would have been expected to determine the optimum amounts / ranges of ingredients. One would have been motivated to do this in order to develop a composition that would have been effective in killing insects, but yet non-toxic to humans. With respect to rose bushes and ornamentals, said plants are species within the plant genus; the instant method to said named plants. One would have been motivated to do this since rose bushes and ornamentals are species within the plant genus.

Response to Applicants' Argument

Applicant argues that the only emulsifier disclosed in Wilkins is MAZCLEAN EP. Wilkins fails to disclose a food grade insecticidal composition that comprises castor oil. Mazclean EP is not listed as a Generally Recognized As Safe (GRAS) chemical.

Examiner response: The specification on page 4 defines "food grade" components as being "(Generally Recognized as Safe)". This language does not exclude ingredients taught by Wilkins, Jr. since it is unclear as to what is meant by a "food grade" component being "(Generally Recognized as Safe)". What does the phrase "(Generally Recognized as Safe)" mean?

With respect to the obvious inclusion of PEG castor oil in Wilkins, Jr., Wilkins, Jr. teaches that any suitable surfactant (e.g. Mazclean) can be added to his composition. Therefore, Wilkins, Jr. is somewhat broad to the surfactant added to the composition. For this reason, it would have been obvious to include the PEG castor oil in Wilkins, Jr.'s composition to arrive at instant invention. The Applicant does not provide any data showing why PEG castor oil is critical for the instant invention. Why wouldn't any surfactant be suitable? Until the Applicant provides a showing demonstrating the significance of PEG castor oil, the examiner maintains that Wilkins, Jr. makes obvious that any surfactant including PEG-castor oil would have been suitable for the invention taught therein. For the reasons stated above, the Examiner finds it necessary for the Applicant to provide a showing of unexpected results obtained from using PEG castor oil in the instant invention as opposed to any other surfactant like Mazclean EP. Note Wilkins, Jr.'s invention is open to any suitable surfactant which may include PEG castor oil. Applicants do not show the significance of PEG castor oil as opposed to any suitable surfactant. Note Mazclean EP is only provided in Wilkins Jr.'s paper as an example of a suitable surfactant. For this reason the rejection over Wilkins, Jr. is maintained.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:
10/692,512
Art Unit: 1616

Page 12

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Alton Pryor', with a horizontal line extending from the end of the signature.

Alton Pryor
Primary Examiner
AU 1616